



AF
#12 2773

PATENT
Attorney Docket No.
98 0674

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of : Grooters
Serial No. : 09/238,375
Filed : January 27, 1999
Art Unit : 2773
Examiner : Luu, S.
Title : *METHOD AND APPARATUS FOR AUTOMATICALLY
GENERATING A DEVICE USER INTERFACE*

Appeal No.:

RECEIVED
SEP 05 2001
Group 2100

Assistant Commissioner for Patents
Washington, D.C. 20231

APPELLANT'S REPLY BRIEF

(1) REPLY TO EXAMINER'S ANSWER AND RESPONSE TO ARGUMENT

Group 1

The Examiner asserts, for the first time, that a device database is inherently included in the resource database [part (a)], and that such an implementation is a design choice [part(b)]. The Examiner further asserts that an alternative implementation is disclosed in which a central database is employed. However, as stated in the Appellant's Brief, such a modification would render the reference unsatisfactory for its intended purpose, and is therefore improper. See *MPEP* § 2143.01 and *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). For example, according to the Douma reference, separate databases are provided to overcome the "inconvenient procedure" of using a central controlling device. Even assuming that such a proposed modification could be made, such a modification would destroy the very intent of the Douma reference.

Additionally, inherency and obviousness are distinct concepts.

[T]he inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily

known. Obviousness cannot be predicated on what is unknown.”
In re Spormann, 363 F.2d 444, 150 USPQ 449 (C.C.P.A. 1966).

Therefore, the Examiner still must show how such a proposed inherency would be known, and how inherency would render the proposed modification obvious.

Again, the Appellant requested that the Examiner supply an affidavit or a reference supporting his assertion, and again, the Examiner has failed to do so. It is respectfully submitted that the Examiner has argued inherency in lieu of such an affidavit or reference because there is no such teaching, suggestion, or motivation included in Douma, alone or in combination with any of the mentioned references. Further, it is respectfully submitted that the Examiner has, through a new inherency argument, made an impermissible new ground of rejection, as stated under *MPEP* §1208.1. As a result, this argument should be withdrawn from consideration as improper. In any event, the argument does not render the claims unpatentable.

The Examiner, in part (c), asserts that at Col. 7, Lines 12-30, means for performing the same operations as required by the claimed user interface generator and layout manager are shown. Again, the Examiner, instead of showing each and every aspect of the claimed invention, generally asserts that such teaching “in effect” is disclosed by Douma. Thus, the Examiner has not made a *prima facie* showing of obviousness.

Per parts (d) and (e), in which the Examiner responds to the Appellant’s assertion of a lack of teaching or motivation of a centralized database, the Examiner asserts that a centralized database is a design choice “As long as the goal in providing the necessary device/component information to the processor for generating the proper interface specific to the requested device is achieved.” *Examiner’s Answer*, Pages 7-8. As discussed earlier, such a “design choice” would run counter to the teachings and disclosure of the Douma reference. As is well settled, “there must have been something present in those teachings to suggest to one skilled in the art that the claimed invention before the court would have been obvious.” *W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 311 (Fed. Cir. 1983) *citing In re Bergel*, 292 F.2d 955, 956-957, 130 USPQ 206, 208 (C.C.P.A. 1961), *cert. denied*, 469 U.S. 851 (1984).

Group 2

Regarding Claims 3 and 4, the Examiner asserts for the first time that “by having the resource database, which inherently includes the device list/database, in the Douma’s system pre-created, these databases would already have been available for accessing without requiring user intervention.” As stated above, such a teaching is not inherent in the Douma reference, and further, inherency and obviousness are separate considerations.

Group 3

Regarding Claims 12 and 17, the Examiner states, “where the device is not listed in the database, a way to handle such a situation would be necessary” and then asserts that it would be reasonable to combine the teachings. However, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580. *See also In re Wilson*, 165 U.S.P.Q. 494. In this case, the Examiner has impermissibly used the present application as a template, and has not shown where in the submitted references such a motivation exists.


Accordingly, a *prima facie* case of obviousness has not been established and reversal of the Examiner’s rejection is respectfully requested.

CONCLUSION

For the above reasons, it is respectfully requested that in each of the rejections discussed herein under 35 U.S.C. §103(a), the Examiner has failed to meet the burden in establishing a *prima facie* basis for the rejections. The Examiner has not shown all the claim limitations, has asserted motivation and proposed modifications inconsistent with the references, and further, has newly asserted an inherency argument in an attempt to correct the defects of the references. Accordingly, reversal of all outstanding rejections is earnestly solicited.

Respectfully submitted,
Gateway, Inc.

Dated: August 29, 2001

By: 
William J. Breen, III
Reg. No. 45,313

William J. Breen, III
SUITER & ASSOCIATES PC
14301 FNB Parkway, Suite 220
Omaha, NE 68154
(402) 496-0300 telephone
(402) 496-0333 facsimile